

REMARKS

The present invention relates to a cryogenic canister for biological specimens. The canister includes a box having a lid and a base. The base has a bottom wall and a base sidewall which extends outwardly from the bottom wall around the entire outer periphery. Similarly, the lid has a top wall and a lid sidewall which extends outwardly from the top wall around the entire outer periphery of the top wall. Furthermore, the lid is dimensioned so that the lid overlies the base sidewall and forms a box having an interior chamber which is adapted to contain biological specimens. In order to secure the lid and base together, a pair of U-shaped clips are provided on opposed sides of the box so that one leg of each clip overlies the top wall while the other leg of each clip overlies the bottom wall. Additionally, both the lid and the base are made of a cardboard construction.

In the Patent Examiner's final Office Action of August 14, 2006, the Patent Examiner has again rejected claims 1-3 as unpatentably obvious under 35 U.S.C. §103 over U.S. Patent No. 3,231,076 to Freiman. Applicant, however, respectfully submits that this basis for rejection is in error and should be withdrawn.

More specifically, Applicant has argued, *inter alia*, that in the Freiman patent the sidewalls of the base and lid do not overlap each other as in Applicant's invention. In response to this argument, the Patent Examiner in paragraph 2 of the August 14, 2006 Office Action has stated in part:

"There is no requirement in the claims for the sidewalls to overlap while the clip is holding the lid and base together."

This, however, is not correct.

In particular, claim 1, the only independent claim in this application, clearly defined in lines 6-9, that the lid sidewall overlies the base sidewall. The term "overlie" means that the lid sidewall overlaps the base sidewall.

Additionally, it is rudimentary that the patent claims must be interpreted in view of the patent specification. In this regard, see page 4, lines 10-13 of the patent specification where the specification states in part:

"Furthermore, as best shown in FIG. 3, with the lid position on the base 16, the lid sidewall 24 overlies the base sidewall 20 and forms the chamber 26 between the lid 14 and base 16."

FIG. 3 of the patent drawing, furthermore, clearly shows that the lid sidewall 24 overlaps the base sidewall 20.

Since the patent claims must be interpreted in light of the specification, and since the specification clearly defines that the term "overlie" means that the lid sidewall 24 overlaps the base sidewall 20 as shown in FIG. 3, the claims must be interpreted to include that limitation. When that is done, it is clear that the Freiman patent does not teach or suggest such a construction. Indeed, the opposite is true. In the Freiman patent, the spacers are provided specifically to space the ware vessels 11a and 11b apart as shown in FIG. 2. This, of course, is the intended use of the Freiman spacer-retaining clip.

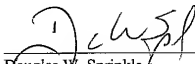
To modify the Freiman spacer-retaining clip so that it no longer provides that spacing function would be to modify the Freiman spacer clip so that it no longer functions in its intended fashion. A modification of a prior art reference which renders that reference inoperable for its intended use cannot be obvious within further view of 35 U.S.C. §103; see *Diamond International Corporation vs. Walterhoefer et al.*, 159 USPQ 452 (1968), and *Ex parte Weber*, 154 USPQ 491 (1967), in which the Board said in part as follows:

"It is our opinion that the cited prior art does not teach that it would be obvious to rearrange the machine of Hempel et al. as proposed by the examiner. To do so, would completely alter the construction and mode of operation of the stencil cutter of Hempel et al., so that it would not function in its intended manner. It appears to us that the obviousness of the proposed changes is not derived from the cited prior art, but only from appellant's disclosure." 154 USPQ at 492.

For all of the foregoing reasons, Applicant respectfully submits that claim 1, the only independent claim in the instant application, patentably defines Applicant's invention over the prior art references of record and is, therefore, allowable. The remaining claims depend from claim 1 and are, therefore, also allowable.

In view of the foregoing, Applicant respectfully submits that this case is in condition for allowance, and such action is respectfully solicited.

Respectfully submitted,



Douglas W. Sprinkle
Registration No. 27,394
Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, P.C.
P.O. Box 7021
Troy, Michigan 48007-7021
(248) 647-6000

Attorney for Applicant

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